

REMARKS

Claims 38, 40 and 43-45 are pending and being examined.

Clarification Of Inventorship:

In the Office Action, the Patent Office indicates that the inventorship of the subject application has been clarified upon review of Applicants' previously submitted papers. The Patent Office states the inventors of the subject application are: Linsley, Ledbetter, Damle, and Brady.

Additionally, Applicants are pleased the Patent Office has withdrawn the rejection of the claims under 35 U.S.C. §102(e) and (f).

Terminal Disclaimer:

In the Office Action, the Patent Office rejects claims 38, 40 and 43-45 under the judicially created doctrine of obviousness-type or non-obviousness-type double patenting as allegedly unpatentable over claims 1-9 of U.S. Patent No. 6,641,809.

Specifically, the Patent Office states, "The pending and patented claims are drawn to the use of the same or nearly the same B7 protein comprising the same extracellular B7 domain to inhibit B cell-T cell interactions." (Office Action, page 2).

This is the sole remaining rejection of record and a submission of a Terminal Disclaimer shall place this case in condition for allowance. Accordingly, Applicants provide herein a Terminal Disclaimer (Exhibit 1) and a copy of a recorded assignment for U.S. Serial No. 07/722,101, now U.S. Patent No. 6,641,809 (Exhibit 1A).

Applicants also provide herein a Certificate under 37 C.F.R. §3.73(b) (Exhibit 2), and a copy of recorded assignments for U.S. Serial Nos: 08/228,208 (Exhibit 2A); 08,008,898 (Exhibit 2B); and 07/723,617 (Exhibit 2C).

U.S. Patent No. 6,641,809 and the subject application are both owned by The Bristol-Myers Squibb Company. Applicants provide herein a Certificate under 37 C.F.R. §3.73(b), and copies of executed assignments and Notice of Recordation of Assignment Document, establishing the status of The Bristol-Myers Squibb Company as assignee for U.S. Patent No. 6,641,809 and the subject application.

In addition, Applicants submit herein a Terminal Disclaimer executed by Christopher A. Klein, Senior Counsel, Biotechnology Patents of the Bristol-Myers Squibb Company.

In the enclosed Terminal Disclaimer (Exhibit 1), Christopher A. Klein states that the Bristol-Myers Squibb Company is the owner of all right, title and interest in the above-identified application, and it disclaims the terminal part of any patent granted in this application which would extend beyond the expiration date of U.S. Patent No. 6,641,809, issued November 4, 2003.

Further, The Bristol-Myers Squibb Company agrees that any patent granted on the above-identified application shall be enforceable only for and during such period that the legal title to such patent be the same as the legal title for U.S. Patent No. 6,641,809.

In view of the Terminal Disclaimer, Applicants request that the Patent Office reconsider and withdraw the rejection under the judicially created doctrine of obviousness-type or non-obviousness-type double patenting.

Applicants: Peter S. Linsley, et al.
U.S. Serial No: 09/454,651
Filed: December 6, 1999
Page: 5

Conclusion:

Entry of this amendment and the foregoing remarks are respectfully requested. Applicant believes that all grounds for rejection of the claims have been overcome and that claims 38, 40 and 43-45 are now in condition for allowance. Withdrawal of the Patent Office's rejections is requested and prompt allowance of the claims is solicited. If any issues remain in connection with the claim, the Examiner is encouraged to contact the undersigned by telephone to discuss the same.

Only the fee for a one-month extension of time is deemed necessary in connection with the filing of this Amendment. The fee for the one-month extension of time is \$110.00. A check for \$110.00 is enclosed. If any additional fee is necessary, the Patent Office is authorized to charge any additional fee to Deposit Account No. 50-0306.

Respectfully submitted,



Sarah B. Adriano
Registration No. 34,470
Roberta D. German
Registration No. 43,902
Patent Practitioners for Applicants
Mandel & Adriano
55 So. Lake Ave., Suite 710
Pasadena, California 91101
(626) 395-7801
Customer #:26,941